REMARKS

Claims 4, 6, 37, and 41 have been cancelled, and claim 47 has been previously cancelled. Claims 1, 2, 5, 7, 8, 10-12, 14-17, 19-21, 24-27, 30-32, 34, 38-40, 42, 46 and 48 have been amended; however, no new matter has been introduced. Claims 3, 13, 22, 23, 28, and 45 are as previously presented, and claims 9, 18, 29, 33, 35, 36, 43, and 44 are as originally filed. With these amendments, claims 1-3, 5, 7-36, 38-40, 42-46, and 48 are pending.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 1-6, 14-17, 19-22, 24-28, 30, 32, 33, 46 and 48 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. In particular, the Office asserts that the specification discloses four (4) ring systems, but that the combination of substituents X, Y, and Z allows for many more combinations. The applicants disagree, but, to expedite prosecution, Applicants have amended the scope of X, Y, R^{30}, R^{31}, R^{1}-R^{7}, and R^{9} to correspond more closely to the scope exemplified by the compounds of the invention. The applicants respectfully submit that the one of the skill in the art, given the disclosure found in the specification, would be able to practice the invention. Specifically, Schemes 1-27 and Examples 1-15 provide ample guidance on how to prepare the compounds of the invention, and therefore, practice the invention.

Applicants respectfully request reconsideration and withdrawal of the rejections under 35 USC § 112, first paragraph.

Rejection under 35 U.S.C. § 112, second paragraph

Claim 1-8, 10-17, 19-22, 24-28, 30-42, 44, 46 and 48 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite. In particular:

a., m., and n. The Office rejected claims 1, 34 and 36 for reciting the variable "R^{77}", when there is no such variable in the claims. In response, Applicants have deleted the recitation of "R^{77}" from the claims, thereby obviating this rejection.

b-i., and k. The Office rejected claims 6, 8, 12, 14, 15, 17, 21, 27, and 30 for reciting "R^{33}, R^{34}" (the last line of each claim) for lack of antecedent basis. Applicants have deleted this recitation from the claims.

j. The Office rejected claim 30 for improperly depending on claim 29. In response, the dependence of claim 30 was amended to correctly depend on claim 26.

l. The Office rejected claim 31 for reciting the limitation "4,4-dimethyl" in the species, asserting that there is insufficient antecedent basis for this term. Although the claim recites "1,4,4-trimethyl" and not "4,4-dimethyl," Applicants assumed that the examiner was referring to lack of antecedent basis for the two methyl groups at 4,4-positions.To expedite the prosecution, Applicants amended claim 31 to depend on claim 1.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 USC § 112, second paragraph.

Rejection under 35 U.S.C. § 102(b)

Claim 1 was rejected under 35 USC § 102(b) as being anticipated by Janssen *et al.* (U.S. Pat. No. 5,461,050.) In particular, the Office asserts that the reference discloses two compounds, Example 5 c) and 5 d) in column 38, that read on the claims.

For these compounds to anticipate the claims, R^1 would need to be hydrogen, and R^4 or R^5 would need to be $-N(R^{15})R^{16}$. But the definition of R^1 in the present claims does not include hydrogen, not does the definition of R^4 or R^5 include $-N(R^{15})R^{16}$. Therefore, these two compounds of Janssen do not anticipate the current claims. Reconsideration and withdrawal of rejection under 35 U.S.C. § 102 (b) is respectfully requested.

Claim Objections

a. and d. The Office objected to claims 1 and 46 for reciting a lower case "z" in formula (I) but upper case "Z" in the definitions. In response, Applicants have amended formula (I) to recite upper case "Z".

b. and c. The Office objected to claims 5 and 39 for reciting a period in the middle of the claim, specifically after part d) and before part e). Applicants have deleted this recitation from claims 5 and 39.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the claim objections.

Improper Finality of the Office Action

Applicants respectfully submit that the finality of the pending Office Action is improper, under the procedure for examining set forth in MPEP § 706.07(a), which states:

> Under present practice, second or any subsequent actions on the merits shall be final, **except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement** filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 609.04(b). Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings **will not be made final if it includes a rejection, on newly cited art,** other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. Where information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment.

(Emphasis added.) The Applicants submit that, according to MPEP § 706.07(a), a second or a subsequent action on the merits cannot be made final if it includes a new ground of rejection (for example, a rejection based on newly cited art) that is necessitated neither by Applicant's amendment of the claims nor by information submitted in an IDS.

In the currently pending final Office Action the Office issued two rejections on new grounds, neither of which were necessitated by the Applicant's claim amendments. In particular, the Office issued a new rejection under 35 USC § 102 citing new prior art (Janssen *et al.*). In fact, this is the first prior art rejection that has been issued in this application. This art was not cited in an IDS, nor was it necessitated by the previous amendments. And, furthermore, it in fact is not anticipate claims is explained above.

The Office also issued a rejection under 35 USC § 112, first paragraph, raising issues that were not previously raised. Previously, the Office rejected claims 1-5 and 32-48 for lack of enablement for the terms "solvates", "polymorphs", and "prodrug", and claims 32-42, 44, and 48, for lack of enablement for the terms "esters", "enol ethers", etc. In response to these

rejections, Applicants amended the claims to remove these terms resulting in the claims with reduced scope. In this Action, the Office issued a new enablement rejection based on the definitions of X, Y, Z, R^1, etc. This enablement rejection was not previously raised and not necessitated by the claim amendments as the same definitions of X, Y, Z, R^1, etc., as presently pending were previously pending.

In view of both newly cited § 102 art and new grounds of rejections under 35 USC § 112, Applicants respectfully request that the finality of the pending Action be withdrawn. On July 19, 2011 Applicants submitted a petition to the technology center Director for withdrawal of the finality of this action.

If there are any questions or comments regarding this application, the Examiner is encouraged to contact the undersigned in order to expedite prosecution.

Respectfully submitted,

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